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MAILED
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OFFICE OF PETITIONS

In re Patent No. 5,779,392 : DECISION ON PETITION
Issue Date: July 14, 1998 :
Application No. 08/719,520 :
Filed: SYSTEMS FOR CONTAINING AND :
COLLECTING OIL SPILLS :
:

This is a decision on the petition under 37 CFR 1.378(b), filed April 23, 2012, to accept the delayed payment of the second and third maintenance fees for the above-identified patent.

The petition under 37 CFR 1.378(b) is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The above-identified patent issued on July 14, 1998. The second maintenance fee could have been paid during the period from July 14, 2005 through January 17, 2006 or with a surcharge during the period from January 18, 2006 through July 14, 2006. Accordingly, the above-identified patent expired on July 15, 2006, for failure to timely remit the second maintenance fee.

On January 11, 2012, petitioner filed a petition under 37 CFR 1.378(b), requesting the acceptance of the late payment of the maintenance fees for the above-identified patent due at 7.5 and 11.5 years. On April 2, 2012, the Office mailed a Request for Further Information. In response, petitioner filed the present petition under 37 CFR 1.378(b) on April 23, 2012.

In support of the petition, petitioner asserts:

The timely payment of maintenance fees were unavoidably delayed due to catastrophic health reasons. Our first maintenance payment was due in the first quarter of 2006. My disabilities first appeared in 2003 as is listed below. They continued to limit my ability to work throughout 2010 when the next maintenance payment was due. I have talked with several representative of the U.S. Patent Office to learn what is required to resolve this issue. I have spent many countless hours gathering supporting evidence of my ongoing health problems, as is evidenced by the amount of paperwork attached (see attached for supporting documentation.) It is my sincere desire to fulfill my obligations regarding my patent.

- In November of 2003 I received a diagnosis of a pseudotumor/shingles in the right eye. This event resulted in permanent scarring of the cornea, which prevented me from daily activities such as driving and using a computer.
- In January of 2004 I suffered a severe stroke. It resulted in full paralysis of my left side. I was unable to sit or stand on my own. Years of therapy ensued until only a basic amount of mobility had been achieved. My fields of vision were permanently damaged.
- In July of 2008, I suffered a type heart attack known as the “widow maker.” Three stents were installed with therapy to follow.
- In November of 2009 I had an unsuccessful ankle replacement. The prosthesis was loose inside the ankle and caused me to be confined to a wheel chair for approximately a year and a half.
- In October of 2010 I had the corrective surgery for the ankle. Again, I was not ambulatory for about six months.
- In October of 2011, I had additional foot and ankle surgery, part of which was corrective measures to repair stroke damage. The surgery realigned my gait and helps to correct a dropped foot. I am still not fully ambulatory.

Copies of petitioner's medical records and letters from his treating physicians accompany the petition.

A petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct

knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. As stated in Section 711.03(c)(II)(C)(2) of the Manual of Patent Examining Procedure:

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Section 2590(I) of the Manual of Patent Examining Procedure further explains:

As 35 U.S.C. 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. [Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).] That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3)

preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. [See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).] See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). In this instance, petitioner was the patent owner at the time of the expiration of the patent, and therefore, petitioner had an obligation to ensure the timely payment of the maintenance fee.

While physical incapacitation can be a cause of delay, a showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such a nature and degree as to render petitioner unable to conduct business (e.g. correspond with the Office) during the entire period from when the maintenance fee was due until the filing of a grantable petition. Such a showing must be supported by a statement from petitioner's treating physician(s), and such statement must provide the nature and degree of petitioner's incapacitation during the entire aforementioned period.

As a threshold matter, the Office notes that an adequate showing of unavoidable delay in payment of the maintenance fee requires a demonstration of the steps that were taken to ensure the timely payment of the maintenance fees for this patent. In the absence of a showing that petitioner was (1) aware of need to pay the second and third maintenance fees and (2) he took steps to ensure timely payment, 37 CFR 1.378(b) precludes acceptance of the payment. In other words, if petitioner was unaware of the need to pay the maintenance fees and no steps were taken by petitioner to track the maintenance fee due dates and ensure timely payment, then any concurrent and subsequent health problems of petitioner would be immaterial to the delay. The showing must be that when the petitioner's system indicated the maintenance fees fell due, his health problems "unavoidably" prevented him from taking any earlier action with respect to this patent.

In the Requirement for Information, mailed April 2, 2012, the Office requested that petitioner show that the maintenance fee due date for this patent had in fact been entered in a maintenance fee tracking system. Additionally, the Office urged petitioner to provide a statement as to how that system operated and to include any supporting documentation. In response, petitioner provided a letter dated October 27, 2005, from Carol Ann M. Slivinskas, a Tax Administrator at McCormick, Paulting & Huber LLP, to petitioner regarding payment of the maintenance fee for this patent. The letter requested that petitioner return the form to her by December 1, 2005, with instructions to either mark "P" to pay the maintenance fee, accompanied a check in the appropriate amount, or to mark "C" to cancel and make no payment of the maintenance fee. The letter advised petitioner that failure to provide payment of the maintenance fee would result in a lapse of the patent. Unfortunately, petitioner did not provide the USPTO with a copy of the enclosures that accompanied the letter. Additionally, petitioner did not specifically indicate whether he or his designee had completed and returned the form (marking "P" or "C") by the date requested. Lastly, petitioner did not indicate if he had any further communications with a member of the firm regarding payment of the maintenance fee. Accordingly, petitioner must provide the USPTO with a copy of the enclosures and a statement from his former patent practitioner, Chester Flavin, regarding any communications between them regarding the payment of the second or third maintenance fees.

Additionally, the Office requested that petitioner submit further information demonstrating that his medical incapacitation was of such a nature and degree as to render him unable to conduct business (e.g., correspond with the Office) during the entire period from the maintenance fee was due on July 14, 2006, to the present. The Office asked petitioner to explain how he was able to travel to and from medical appointments, pay his bills, and maintain his affairs during this period of time, but was unable to make timely payment of his maintenance fees. Furthermore, the Office requested that petitioner state why he did not enlist the aid of others to assist him in managing his patent affairs to ensure the timely payment of the maintenance fee as a reasonable and prudent person would have done with respect to his most important business. In response to these request, petitioner provided a signed and notarized affidavit from his wife stating:

THIS IS TO AFFIRM THAT ALTHOUGH MY HUSBAND, JOSEPH MENDES AND I DID RECEIVE NOTIFICATION FROM OUR PATENT ATTORNEY OF THE REQUIREMENT TO PAY MAINTANENCE FEES DUE ON HIS PATENT, MY HUSBAND'S HEALTH ISSUES WERE DEBILITATING ENOUGH TO PREVENT US FROM ATTENDING TO THEM IN A TIMELY MANNER. AS DETAILED IN THE SHOWING, HIS SERIES OF HEALTH ISSUES

REQUIRED HIM TO HAVE 24 HOUR A DAY ASSISTANCE WITH BASIC LIFE FUNCTIONS SUCH AS EATING, BATHING, READING AND GETTING TO AND FROM THE BATHROOM. THE AMOUNT OF TIME AND ATTENTION REQUIRED TO MANAGE HIS HEALTH NEEDS, MY OWN NEEDS AND OUR MUTUAL INTERESTS WERE OVERWHELMING. I SIGNED FOR A CERTIFIED LETTER FROM OUR PATENT ATTORNEY REMINDING US OF THE FEES OWED. A COPY OF THE REMINDER LETTER IS ATTACHED. BECAUSE THIS TASK WAS NOT ESSENTIAL TO THE NECESSITIES OF LIFE, IT UNFORTUNETLY BECAME COMPROMISED.

MY HUSBAND DID NOT RETURN TO WORK AFTER HIS STROKE. HIS REHABILITATION HAS BEEN EXTENSIVE, REQUIRING YEARS OCCUPATIONAL AND PHYSICAL THERAPY. IMPROVING HIS VISION IS AN ONGOING TASK. THE FAILURE TO PAY MAINTANENCE FEES WAS NOT DUE TO IGNORANCE OR THE LACK OF WILLINGNESS TO PAY. IT WAS SIMPLY TRYING TO MAINTAIN THE ESSENTIALS OF LIFE.

INCLUDED IN OUR PREVIOUSLY SUBMITTED SHOWING IS EXTENSIVE DOCUMENTATION FROM MANY PHYSICIANS AND HOSPITALS INVOLVED IN MY HUSBANDS CARE FROM 2003 TO THE PRESENT. IT IS OUR INTENTION TO PRESENT A CLEAR AND USABLE TIMELINE OF THE ISSUES THAT PREVENTED US FROM FULFILLING OUR OBLIGATION TO THE PATENT OFFICE. PLEASE CONTACT US IF ANY ADDITIONAL INFORMATION IS REQUIRED.

While the Office is very sympathetic to petitioner's medical condition and the hardships he and his wife endured, petitioner has not shown that he acted diligently or took adequate steps to ensure the timely payment of the maintenance fees, which is essential to support a finding of unavoidable delay. See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988) (applicant's diligent inquiry into the status of the application is required to show unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his counsel). There is no "sliding scale" based upon the priority given to maintaining this patent in force, or more diligently seeking reinstatement, *vis-à-vis* other matters. The issue is solely whether the maintenance, or reinstatement, of the patent at issue was conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. Petitioner and his wife assert that petitioner's medical needs were overwhelming causing the timely payment of the maintenance fee to become compromised. Nevertheless, it would appear that that petitioner or petitioner's designee were able to pay his bills for his medical costs and living expenses, as well as maintained his affairs for over five years (from due date for the maintenance fee on July 14, 2006, to the filing of the initial petition); however, they assert that they were unable to pay the maintenance fee.¹ The record fails to adequately evidence that petitioner exercised the due care and diligence observed by prudent and careful persons,

¹ Preoccupation with other matters which took precedence over timely payment of the maintenance fee, as harsh as that may seem does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

in relation to their most important business necessary to establish unavoidable delay. See Ex parte Pratt, 1187 Dec. Comm'r Pat. 31-32-33 (Comm'r Pat 1887). Moreover, petitioner did not demonstrate that steps were taken to ensure the timely payment of the maintenance fees.

Lastly, petitioner has failed to show that his medical condition rendered him unable to conduct business (e.g., correspond with the Office) during the entire period from the last day the maintenance fee could have been paid on July 14, 2006, to the filing of the petition. The Office has reviewed the medical records and letters from petitioner's treating physicians. While both petitioner and his wife have clearly suffered many hardships, the extent of incapacitation throughout the entire period in question is not clear. The letters provided by the treating physician(s) do not state with specificity that petitioner's medical condition was of such a nature and degree as to render him unable to conduct business (e.g., correspond with the Office) during the entire period from the last day the maintenance fee could have been paid on July 14, 2006, to the filing of the petition. Rather, the letters make broad statements as to the duration and degree of petitioner's medical incapacitation. The Office notes that if there were periods of time between July 14, 2006, and the filing of the petition, that petitioner was capable of corresponding with the Office petitioner would be unable to demonstrate that the delay was unavoidable.

In summary, petitioner has not shown that the delay in timely paying the maintenance fees was unavoidable. Therefore, the petition is dismissed.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fees and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable.

Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

The Office again notes that the address listed on the petition differs from the correspondence address of record. As a courtesy, the Office is mailing petitioner a copy of this communication at the address on the petition. If petitioner would like future correspondence directed to him, petitioner must submit a change of correspondence address. The appropriate form (PTO/SB/123) is attached.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
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Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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Conferee: Anthony Knight, Director of the Office of Petitions

Enclosures: Forms PTO/SB/65 and PTO/SB/123

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